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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/631,301	08/02/2000	Yasunari Kimura	JEL 31225	8435

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Stevens Davis Miller & Mosher LLP
Suite 850
1615 L Street NW
Washington, DC 20036-5622

EXAMINER

LE, DAVID Q

ART UNIT	PAPER NUMBER
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3621

DATE MAILED: 10/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/631,301

Applicant(s)

KIMURA ET AL. *h*

Examiner

David Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1-5** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Foladare et al**, US Patent No. 5,914,472.

As per **claim 1**:

Foladare discloses a transaction control/authorization method comprising the steps of:

- (a) *receiving a member ID information from a user through an open information communication line*; (Abstract; Fig 2, related description);
- (b) *identifying a member by comparing a member ID information registered in a member database and the member ID information from the user* (Fig 2, related description);
- (c) *requesting connection to a mobile communication terminal of the member by using a mobile communication terminal number registered in said member data base when the member is identified* (Fig 2, steps 210-216, related description); and
- (d) *judging authentication when an authentication approval signal is received from said mobile communication terminal* (Fig 1, steps 116, 120, related description; Col 3, lines 2-33).

Foladare is directed toward controlling access to an account owned by one user when an "ancillary" user is attempting to use the account, either buying a service or product. *Foladare* teaches how a bank/credit card issuer may "double-check" whether access to a payment account is truly authorized, whether in the absolute, or only up to a certain monetary level, by contacting the account owner and requesting an unequivocal confirmation. It would have been obvious to one ordinarily skilled in the art at the time the invention was made to apply *Foladare*'s invention to an authorization system for credit/debit/charge account transactions where fraud is a high-level concern. Instead of just requiring a confirmation whenever an ancillary user is involved, all transactions will require such a confirmation from the account owner, thus minimizing the risk of card/account information loss and their being used for fraudulent transactions or access to services.

As per **claim 2**:

Based on the same analysis as per claim 1 above, *Foladare* discloses a transaction control/authentication apparatus comprising:

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a member database registering an information of members (Figs 2-3, related description; Col 2, lines 53-64);

an individual authentication control means for receiving a member ID information from a user, through an open information communication line (Fig 2, related description);

a basic authentication means for identifying a member by comparing a member ID information registered in said member database and the member ID information received from said individual authentication control means (Fig 2, database 208, and Fig 3, database 224, related description); and

a mobile communication authentication means for requesting connection to a mobile communication terminal of the member using a mobile communication terminal number registered in said member data base, when the member ID from the user is authenticated by said basic authentication means (Fig 1, blocks 110,112, 114, related description);

wherein said authentication apparatus judges that the authentication is successful, when receiving an authentication approval signal from said mobile communication terminal (Fig 1, block 116, related description).

As per **claim 3**:

Based on the same analysis as per claim 1 above, Foladare discloses a [accounting] method comprising the steps of:

receiving a member ID information from a user and an accounting amount relating to a service, through an open information communication line (Fig 1, steps 100,102, related description);

identifying a member by comparing a member ID information registered in a member database and the member ID information from the user (Fig 2, step 104, database 208, and Fig 3, database 224, related description; Col 4, lines 23-35);

requesting connection to a mobile communication terminal of a debtor by using a mobile communication terminal number registered in said member data base, when the member is identified (Fig 1, blocks 110,112, 114, related description);

inquiring approval or rejection of a payment of a charge to the debtor (Fig 1, block 114, related description); and

registering the accounting amount in said member database together with an information about service presentation, when receiving a signal approving the payment of the charge by the debtor from said mobile communication terminal, and deducting the accounting amount from a bank account registered preliminarily (Figs 2-3, related description; Col 3, lines 15-33).

As per **claim 4**:

Foladare discloses a method as defined in claim 3 further comprising the step of:

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receiving a facility ID information of a facility for the service presentation, through the open information communication line; and identifying the facility . (In Col 3, lines 30-33, Foladare discloses that a merchant name is a component of the information transmitted and used for authorization).

As per claim 5:

Based on the same analysis as per claims 1-4 above, *Foladare discloses an apparatus comprising:*

a member database registering an information of members;

accounting authentication control means for receiving the member ID information from a user and accounting amount relating to a service, through an open information communication line;

basic authentication means for identifying a member by comparing a member ID information registered in said member database and the member ID information received from said accounting authentication control means;

mobile communication authentication means for requesting connection to a mobile communication terminal of a debtor registered in said member database, when the member ID from the user is authenticated by said basic authentication means.

Foladare does not specifically disclose a means for deducting the transaction amount from the user's account in his description. However it would have been obvious to one ordinarily skilled in the art at the time the invention was made that such a step would be inherent in maintaining said account up to date at the authorization center, so that the account user may continue to use the account and his balance be carried forward accurately. As a result, the last limitation of claim 5 would be anticipated by Foladare's invention, namely:

accounting means for deducting the accounting amount from a bank account registered preliminarily, and registering the accounting amount in the database together with an information about service presentation, when receiving an approval signal for the accounting amount from the mobile communication terminal of the debtor.

3. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Foladare in view of Walker et al, US Patent No. 6,327,348 B1.

Based on the same analysis as per claims 1-5 above, *Foladare* meets all the limitations cited by claim 6, except that he does not specifically describe maintaining a database of merchant/service provider accounts at the authorization center for the purpose of further authentication/authorization of a requested transaction or service access.

Walker discloses a similar authorization control system for transactions involving debit/credit card/charge accounts, wherein merchant/service provider accounts are maintained in a database and identification information from those accounts would be part of the initial authorization request and subsequent authentication/authorization process (Figs 4, 6, related description; Col 9, lines 18-30). *Walker* teaches that each transaction to be authenticated and authorized should comprise unique merchant information as well as unique user information,

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because each such element may be used in the authentication/authorization process, as well as subsequent account reconciliation and record keeping.

Therefore it would have been obvious to one ordinarily skilled in the art at the time the invention was made to use such merchant/service provider identification data in a system inspired by *Foladare* and *Walker*, for the purpose of providing an even stronger authentication mechanism: only registered merchants/service providers and registered users may be cleared for transactions. Such a system would meet all the limitations of claim 6, namely:

An accounting apparatus as defined in claim 5 further comprising:

a facility database registering the information of service presentation facility; and facility authentication means,

wherein said accounting authentication control means further receives a facility ID information for identifying the facility, through the open information communication line,

wherein said facility authentication means identifies the facility by comparing a facility ID information registered in said facility database and the facility ID information received from said accounting authentication control means, and

wherein said mobile communication authentication means

requests connection to the mobile communication terminal of the debtor registered in the member database, when the facility ID and member ID are authenticated by said facility authentication means and said basic authentication means.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

DQL
October 18, 2002


JAMES P. TRAMMELL
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600